



10-17-06

JFW

PTO/SB/21 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/810,711	
	Filing Date	March 26, 2004	
	First Named Inventor	Antony Bigot et al.	
	Art Unit	1625	
	Examiner Name	Binta M. Robinson	
Total Number of Pages in This Submission		Attorney Docket Number	8674-000021

**ENCLOSURES (check all that apply)**

<input type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/ Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <b>Return Receipt Postcard</b>		
<table border="1"><tr><td>Remarks</td><td>The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.</td></tr></table>			Remarks	The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.
Remarks	The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.			

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name Monte L. Falcoff Jennifer M. Woodside Wojtala	Reg. No. 37,617 50,721
Signature	<i>Jennifer Woodside Wojtala</i>		
Date	October 16, 2006		

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Monte L. Falcoff / Jennifer M. Woodside Wojtala	Express Mail Label No.	EV 757 778 131 US (10/16/2006)
Signature	<i>Monte L. Falcoff</i>	Date	October 16, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

EV 757 778 131 US



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/810,711  
Filing Date: March 26, 2004  
Applicant: Antony Bigot et al.  
Group Art Unit: 1625  
Examiner: Binta M. Robinson  
Title: 4-SUBSTITUTED QUINOLINE DERIVATIVES,  
METHOD AND INTERMEDIATES FOR THEIR  
PREPARATION AND PHARMACEUTICAL  
COMPOSITIONS CONTAINING THEM  
Attorney Docket: 8674-000021

---

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT**

Sir:

In response to the Office Action mailed September 15, 2006, please consider the following. In the above identified Office Action, the Examiner determined that currently pending Claims 1-15, are subject to a restriction requirement pursuant to 35 U.S.C. §121. The Examiner has required restriction to one of the following inventions –

- I. Claims 1-13 and 15, drawn to the compound, composition, process of preparing and intermediate, classified in class 546, subclass 194;
- II. Claim 14, drawn to a method for the treatment or prophylaxis of various bacterial infections, classified in class 514, subclass 249.

In addition, the Examiner has required an election of a single disclosed species, including an identification of the species that is elected and a listing of all claims readable thereon, including any claims subsequently added.

#### **Response to Restriction Requirement**

Applicants traverse the restriction requirement. First, the examination of dependent Claim 14 does not appear to impose a serious burden upon the Examiner. Further, Applicants respectfully submit that the process in Claim 14, which depends from Claim 1, could not be practiced with another materially different product than the product recited in Claim 1. As such, Applicants respectfully submit that the Examiner has not established the distinctness necessary between a process of making and process of using the product, as required by MPEP 806.05(i). In this regard, Applicants request reconsideration of the restriction requirement. However, to facilitate prosecution, Applicants hereby elect to prosecute the claims of Group I corresponding to Claims 1-13 and 15.

The right is hereby reserved to file further continuation and/or divisional patent applications directed to the restricted subject matter and Applicants are not, in any manner, waiving or abandoning any rights to this subject matter.

#### **Response to Election Requirement**

In response to the election requirement, Applicants further elect the following species for prosecution: A compound of formula (I) (of Claim 1) where  $X_1$  is  $C-R'_1$  and  $R'_1$  is H;  $X_2$  is  $C-R'_2$  and  $R'_2$  is H;  $X_3$  is  $C-R'_3$  and  $R'_3$  is H;  $X_4$  is  $C-R'_4$  and  $R'_4$  is H;  $X_5$  is  $C-R'_5$  and  $R'_5$  is a halogen (e.g., F). Further,  $R_1$  is selected to be  $OCH_3$ ,  $R_2$  is  $CO_2R$  where  $R$  is H;  $R_3$  is  $alk-R^\circ_3$ , where  $R^\circ_3$  is  $CR'_b=CR'_c-R'_a$ , where  $R'_b$  and  $R'_c$  are H and  $R'_a$  is 3-(2,5-difluorophenyl)-2-propenyl. Further  $m$  is selected to be 2;  $n$  is selected to be 1;  $Z$  is selected to be  $CH_2$ ; and  $Y$  is  $CHOH$ . The elected species lacks  $R_a$  or  $R_b$ . Thus, the

elected species are isomers of 1-[(2E)-3-(2,5-difluorophenyl)-2-propenyl]-3-[3-(3-fluoro-6-methoxyquinolin-4-yl)-3-hydroxypropyl]-3-pyrrolidine-carboxylic acid (see e.g., Examples 61 and 62 in the specification).

Applicants submit that independent Claim 1, as well as dependent Claims 4 -11 and 15, are readable upon the elected species.

### CONCLUSION


It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this Response is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: October 16, 2006

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600

MLF/JMW

By:   
Monte L. Falcoff  
Reg. No. 37,617

Jennifer M. Woodside Wojtala  
Reg. No. 50,721